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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,969	04/08/2005	Tomoyuki Nakano	KOD175B.001APC	7613
20995	7590	04/06/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			CORDRAY, DENNIS R	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/508,969

Applicant(s)

NAKANO ET AL.

Examiner

Dennis Cordray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/24/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Vinson et al (5958185).

Vinson et al discloses a high bulk tissue paper (col 4, lines 44-46; col 19, lines 52-56) comprising cationic polyacrylamide with a maximum charge density at any pH of 0.2 to 2.5 meq/g (col 10, lines 32-42 and 58-62). The tissue paper also comprises a filler that can be aluminum silicate, calcium silicate or diatomaceous earth (amorphous silica) (col 4, lines 50-56). Diatomaceous earth, or amorphous silica, has a bulk density of 18.7 lb/ft<sup>3</sup> (0.3 g/ml) (if evidence is needed, see Avallone, E.A.; Baumeister, T., III, Marks' Standard Handbook for Mechanical Engineers (10th Edition). McGraw-Hill, (1996), Table 4.4.6). The tissues can also comprise surfactants for extra absorbency. The surfactants preferably have alkyl chains with eight or more carbon atoms (fatty chains) and an exemplary nonionic surfactant is alkylpolyethoxylated esters (ester compound of a polyhydric alcohol and a fatty acid) (col 13, lines 35-47). The instant Specification recites similar ethylene oxide adducts on p 5, lines 21-24. The fibers can also be bridged with the filler particles (col 14, lines 60-64).

The cationic polyacrylamide and alkylpolyethoxylated esters are capable of enhancing the tissue bulk because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent. Similarly, the tissue of Vinson et al comprises the same composition as the claimed tissue and thus is capable of having a relative bonding area of less than or equal to 1.2 times the relative bonding area of tissues not containing polyacrylamide.

Claims 1, 3-5 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Jewell et al (6306251).

Jewell et al discloses a tissue paper having increased bulk that comprises polyacrylamide (col 5, lines 11-22). Since the polyacrylamide is not cationic or anionic, it inherently has a charge density less than 2.0 meq/g. The fibers can be crosslinked (bridged) (col 1, lines 14-17). The tissue can also comprise a debonding agent that can be a fatty aliphatic acid reacted with ethylene or propylene oxide (ester compound of a polyhydric alcohol and a fatty acid) (col 4, lines 19-35). The polyacrylamide and fatty aliphatic acid reacted with ethylene or propylene oxide are capable of enhancing the tissue bulk for the reasons given previously. Similarly, the tissue is capable of having a

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relative bonding area of less than or equal to 1.2 times the relative bonding area of tissues not containing polyacrylamide.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure [Warner et al (5525345), Schroeder et al (US 2002/0004571), Jewell et al (6716306), Dwiggins et al (6896768)]. They pertain to other tissues or bulky tissues comprising polyacrylamide, ethoxylated fatty acids.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DRC



STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700